

## **REMARKS**

Reconsideration of the pending claims in view of the following remarks is respectfully requested.

The specification has been amended to insert the respective serial numbers of co-pending, commonly assigned US Patent Applications referred to therein, as requested by the Examiner.

Claim 5 has been amended, to address the Examiner's rejection for it being indefinite, by introducing the "Markush" language into the claim. Claim 9 has been amended to specify that the printing plate is *obtained by* the method of claim 1.

### **Rejection Under 35 USC § 102(b) over EP 1157828**

Claims 1, 4, and 6-9 were rejected under 35 USC § 102(b) as allegedly anticipated by EP 1157828. According to the Office Action, EP'828 teaches a method for preparing a lithographic printing plate by means of ink jet where ink jet printing droplets of a fluid is dispensed information-wise onto a surface of a lithographic receiver and the ink jet fluid comprises an oleophilizing compound containing a 1,3-dicarbonyl group in its chemical formula (abstract; [0031]). The office action states that the oleophilizing agent is present in the ink in an amount from 0.01 to 6% by weight ([0037]) and a preferred oleophilizing agent, compound I-12, meets the present limitations for the same (Table 1, page 7). According to the office action, the ink jet fluid has a surface tension in the range from 20 to 60, preferably from 30 to 50 dynes/cm ([0042]). The ink is applied to a support (lithographic receiver) and may be any support suitable for printing plates including metallic and polymeric sheets and foils ([0046]-[0051]).

EP'828 is concerned with a method for preparing a lithographic printing plate by means of ink jet in which the ink jet fluid comprises an oleophilising compound containing a 1,3-dicarbonyl group in its chemical formula, which is capable of reacting with the surface of a lithographic receiver onto which the ink jet fluid may be dispensed in an information-wise fashion.

Claim 1, from which claims 4 and 6-9 depend, is directed toward a method for the preparation of a printing plate comprising inkjet printing an oleophilic image on a surface of a support by applying to the support an aqueous solution or

aqueous colloidal dispersion of an oleophilising compound on the surface of the support and drying the applied solution or dispersion, such that on drying the area of the surface to which the solution or dispersion was applied becomes lithographic ink-accepting, characterised in that the oleophilising compound has the chemical structure



or



wherein each M is the same or different and independently selected from H or a cation; each of l, m and n independently is 0 or 1, provided that  $l+m+n = \text{at least } 1$ ; each of R, R' and R'' independently is -H, -B or -L-B; L is a linking group selected from alkylene, alkyleneoxy, thio, sulfonyl, sulfinyl, sulfoxyl, amido, alkylamido, oxyamido, alkylcarbamoyl, carbamoyl, sulfonfylamido, aminosulfonyl, aminosulfonylamido, hydrazinyl-sulfonyl, carboxyl, oxycarbonyl, carbonyl, carboxyhydrazinyl, amino, thiocarbonyl, sulfamoylamino, sulfamoyl, thiocarbamoyl, any one of said linking groups being substituted or unsubstituted; and B is a hydrophobic group comprising 8 or more carbon atoms, provided that at least one of R, R' and R'' is present and has the structure -B or -L-B.

There is no disclosure in EP'828 of an oleophilising compound that falls within the definition of the formulae of claim 1. Claim 1 requires that the  $\text{CO}_2\text{M}$  group is directly linked to a -CH group (either CHR, CHR' or CHR''). In compound I-12 of EP'828, identified by the Examiner, the  $\text{CO}_2\text{H}$  group is attached directly to a *phenyl* group and so does not fall within the scope of claim 1.

Accordingly, EP'828 does not disclose the subject matter of claim 1. For at least the above reason, reconsideration and withdrawal of the rejection is in order.

#### **Rejection Under 35 USC § 102(e) over US 2004/0020388**

Claims 1-9 were rejected under 35 USC § 102(e) as allegedly anticipated by US 2004/0020388. This rejection is respectfully traversed as it is overcome with the Rule 132 Declaration presented with this response by co-Applicant Michael J. Simons. Thus, the cited US Patent Application Publication is not prior art under Section 102(e). A signed copy of the Declaration will be submitted to the

USPTO once it is received from our European patent agent who has advised me that it has been sent.

In view of the foregoing remarks, reconsideration of this patent application is respectfully requested. A prompt and favorable action by the Examiner is earnestly solicited.

Respectfully submitted

A handwritten signature in cursive script, appearing to read "J. Lanny Tucker", written over a horizontal line.

Attorney for Applicants  
Registration No. 27,678

J. Lanny Tucker/s-p  
Rochester, NY 14650  
Telephone: (585) 722-9332  
Facsimile: (585) 477-1148